

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Hossain et al.	Art Unit :	1625
Patent No. :	7,449,475	Examiner :	Aulakh Charanjit
Issue Date :	November 11, 2008	Conf. No. :	9528
Serial No. :	10/520,699		
Filed :	January 7, 2005		
Title :	NOVEL TRICYCLIC SPIROPIPERIDINES OR SPIROPYRROLIDINES		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)

Applicants hereby petition for reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent application. The Issue Notification dated October 22, 2008, for the above-referenced application indicates that the Patent Term Adjustment at issuance is 131 days. Reconsideration of the Patent Term Adjustment calculation to increase PTO Delay from 307 days to 356 days, and to increase Total PTA from 131 to 180 days, is respectfully requested.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

A review of the Patent Term Adjustment History in the PAIR system shows that the United States Patent and Trademark Office (PTO) calculated the Patent Term Adjustment (PTA) as follows:

- 1) The PTO mailed a delayed 14-month first non-final Office Action on January 8, 2007, thereby according a PTO Delay of 307 days, as provided in 37 C.F.R. § 1.702(a)(1). Applicants do not dispute herein this patent term adjustment calculation for this PTO "A Delay."
- 2) Applicants filed a reply to the above-referenced Office Action on July 3, 2007. Applicants were accorded a delay of 86 days for a response outside of the three-month period for reply, as provided in 37 C.F.R. § 1.704(b). Applicants do not dispute herein this patent term adjustment for Applicant Delay.
- 3) The Office mailed a final Office Action on August 27, 2007, to which Applicants filed a reply, a Request for Continued Examination (RCE), on February 25, 2008.

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: December 19, 2008

Applicants were accorded a delay of 90 days for a response outside of the three-month period for reply, as provided in 37 C.F.R. § 1.704(b). Applicants do not dispute herein this patent term adjustment for Applicant Delay.

- 4) The application was filed on January 7, 2005, and the patent issued on November 11, 2008, more than three years later. The earliest RCE was filed on February 25, 2008. No PTO Delay was calculated for issuance of the patent after three years from filing, as provided in 37 C.F.R. § 1.702(b). Applicants respectfully submit that the PTO's calculation of this PTO "B Delay" contains an error and that the correct PTO Delay for issuance beyond three years from filing is 49 days, as outlined further below.

REMARKS

Applicants have calculated the PTA in accordance with the clear intent of Congress. As outlined in *Wyeth v. Dudas* (*Wyeth et al. v. Jon W. Dudas*, U.S. District Court, D.C., CA No. 07-1492, Mem. Op. September 30, 2008), the only way that periods of time can "overlap" is if they occur on the same day, and if an "A delay" occurs on one calendar day and a "B delay" occurs on another, they do not overlap, and 35 U.S.C. § 154(b)(2)(A) does not limit the extension to one day. "A Delays" are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. "B Delays" are defined as delays by the Office under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. §§ 1.702 and 1.703, which guarantee an application pendency of no more than three years.

The PTA for the instant patent, as currently calculated and shown on the face of the patent, relies on the premise that the application was delayed under § 154(b)(1)(B) before the initial three-year period expired.

The *Wyeth* court determined that this construction cannot be squared with the language of § 154(b)(1)(B), which applies "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years," and that "B delay" begins once the PTO has failed to issue a patent within three years, not before.

In the current PTA calculation, "A Delay" should be (and is) calculated as 307 days, but the Office has only given credit for the larger of "A Delay" or "B Delay," rather than the combined sum of "A Delay" and "B Delay" (not including any days after three years from filing where "A" and "B" delays overlap). As no "A Delay" occurred during the period that "B Delay" is calculated – from the day after the date that is three years after the commencement of the national stage (January 8, 2008) through the date of the first RCE (February 25, 2008) – as provided in 37 C.F.R. § 1.703(b), Applicants respectfully submit that there is no overlap in "A Delay" and "B Delay" and thus the total "B Delay" for this patent should be calculated as 49 days. As such, the total PTO Delay should be calculated as 356 days.

In consideration of the events described above, Applicants believe the PTA calculation of 131 days is incorrect. Thus, Applicants respectfully request reconsideration of the patent term adjustment in the following manner:

- 1) Total PTO Delay should be calculated as 356 days;
- 2) Total Applicant Delay should be calculated as 176 days; and
- 3) Total PTA should be calculated as 180 days.

Applicants note that this patent is not subject to a terminal disclaimer.

Please apply the fee of \$200 required under 37 C.F.R. § 1.18(e) and any other required charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: December 19, 2008

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